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IN THE

Supreme Court of the United States

October Term, 1965

No. 444

THE SEVEN-UP COMPANY,

Petitioner,

vs.

THE GET UP CORPORATION,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

WALTER J. HALLIDAY,
60 East 42nd Street,
New York, New York 10017,
Counsel for Respondent.

Of Counsel:
OLIVER P. HOWES, JR.,
BERT A. COLLISON,
M. L. SEVERN,
New York, New York.

AVERY S. COHEN,
Cleveland, Ohio.

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Abbreviation

In this brief the following abbreviation is used:

Pet.	For Petition for Writ of Certiorari followed by the number of a page referred to.

Typography

Petitioner's trademark as shown in its registrations appears both in the word form "SEVEN UP" and a form consisting of the numeral "7" followed by the word "up". Since the numeral form is the form in which it appears in most of petitioner's registrations and is the form in which it is used most prominently on petitioner's bottles and labels and in its advertising, we shall use that form in this brief when referring to petitioner's mark. As registered and used it consists of a large numeral "7" followed by "up" in lower case letters considerably smaller than the numeral. Therefore in this brief, generally, it will be printed thus—7up.

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To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Respondent, The Get Up Corporation, defendant in the District Court, appellee below, prays that this Court not issue a writ of certiorari to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in the above entitled case on January 8, 1965.

I

COUNTER-STATEMENT OF THE CASE

Petitioner incorrectly contends that "only a cursory knowledge of the case" (Pet. 5) is required, and its statement, made accordingly, is insufficient.

Petitioner brought this action in the United States District Court under 15 U. S. C. 1071 and 35 U. S. C. 146 to review certain proceedings between the parties herein in the United States Patent Office, such proceedings having been determined adversely to petitioner, and to enjoin use of respondent's trademark GET UP.

The Patent Office proceedings were brought by petitioner to cancel registrations of respondent's trademark, which had been issued in 1935 and again in 1955, Cancellation Nos. 6528 and 6620, and, also, an opposition by petitioner to an application by respondent for an additional registration of its mark, Opposition No. 35,103. All three proceedings were dismissed by the Trademark Trial and Appeal Board of the Patent Office (520a-525a).

The District Court tried the case without a jury and dismissed the complaint. The Court of Appeals affirmed the dismissal of the complaint and commented that the District Court "heard extensive evidence, made findings of fact, reached conclusions of law, rendered an opinion and dismissed the complaint." A petition to the Court of Appeals for rehearing was denied.[1]

Three separate grounds for dismissal are stated in the District Court's opinion. These are:

First, the Court held that there was no likelihood of confusion between respondent's trademark GET UP and petitioner's trademark **7up** (also SEVEN-UP), as applied to soft drinks (Conclusion 2, 660a). In reaching this conclusion, the District Court stated it applied a test which, as quoted with approval by the Court of Appeals, "relates to producing in the minds of ordinary purchasers, exercising due care in the market place, confusion as to the origin of goods" (547a, Pet. 15). The District Court's application of this approved test was a reason for the Court's ruling

[1] The order of the Court of Appeals appears as Appendix C to the Petition.

that the results of a survey which was submitted by petitioner as showing likelihood of confusion, and which was received in evidence, had no probative value (Finding 36, 657a).[2] No question as to the propriety of such holding is raised by the petition. Application of such test led to the Trial Court's rejection of 100 or more depositions, offered by petitioner, and to refusal to permit 14 witnesses produced in court to answer a question for which no adequate foundation had been laid and which the Court held to be improper.

This evidentiary ruling, which is the *sine qua non* upon which this petition is based, is explained in the opinion of the District Court, thus (552a):

> "In the 100 to 120 depositions which were herein mentioned, the following question was put:
>
> 'Q. When you purchased Get Up, did you have any belief as to what company put it out?' Which is practically the same question as appears in the survey. This third question in these 100 to 120 depositions was considered objectionable by the Court, and answers not permitted as to three witnesses here produced, as to nine on the verge of production as to the 100 to 120 depositions itself because the Court considered the question unfair, misleading and improper; just as much so as question number 3 in the survey."
>
> • • •
>
> "Had all such answers been given as have been called for in all these depositions, and by all these witnesses, as proffered, they would have been entitled to no weight because the questions were improper, and contrary to law."

Thus the District Court found that there was no evidence that defendant had caused confusion or deception of purchasers, and that the trademarks **7up** (or SEVEN-UP) and

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[2] The findings printed at 651a-659a entitled "Defendant's Proposed Findings of Fact" are the findings of the Court. See 663a.

GET UP, used on similar products, are not likely to cause confusion, deception or mistake because they are not similar in sound, appearance or significance (Findings 42-44, 657a-658a).

As a second ground for its dismissal of the complaint, the District Court, finding no credible evidence that there is any similarity between **7up** (also SEVEN-UP) and GET UP except for the word "up" (Finding 38, 657a), and that "up" is a descriptive word with respect to beverages which over the past 50 years has been used in many beverage trademarks (Findings 19-21, 653a-654a), held that the use of the word "up" gave rise to no rights in petitioner against respondent, because petitioner "does not own exclusive right to the use of the word 'up', the use of the word 'up' being free and equal to all" (Conclusion 6, 660a).

The opinion and findings of the District Court list 38 different beverage trademarks of different concerns, all registered in the Patent Office (542a; 654a), and make special note of PIKMEUP, registered in 1907, "over 20 years before any business in **7up** also SEVEN-UP) began", and BUBBLE UP, registered in 1921, which was several years prior to the first use and registration of petitioner's trademark (Findings 21 and 22, 654a).

Finally, as a third ground for dismissing the complaint, the Court affirmed the decision of the Trademark Trial and Appeal Board with respect to petitioner's laches and acquiescence, saying, in the conclusion of the opinion:

> "We find Plaintiff has here proved no case. Had it really had any proper complaint of Defendant's activities, had it proved any case, we find the special defense of laches would have applied. We agree with the Patent Office, that waiting over 20 years to complain * * * constituted laches.
>
> "Defendant's second defense of estoppel is also well taken, in which we also agree with the Patent Office." (556a-557a)

In affirming the judgment, the Court of Appeals referred to the opinion of the District Court as "clear in its holdings" and declared that it found "no error affecting substantial rights" of petitioner.

II

REASONS WHY CERTIORARI SHOULD BE DENIED

A. The Statement by the Court of Appeals That the Opinion Below was Clear in Its Holdings, and That It Found No Error Affecting Substantial Rights of Petitioner, is Sufficient Comment on the Rulings of the Trial Court and the Petition Shows No Reason for Further Review of the Trial Proceedings by This Court.

1. *Contrary to Petitioner's Contention, the District Court Made No Holding That Evidence of Consumer Confusion Properly Presented Under the Rules of Evidence Would Not Be Admissible.*

Petitioner's charge that the District Court by "wholesale exclusion of evidence" so far departed from the accepted and usual course of judicial proceedings as to warrant the exercise of this Court's power of supervision is based largely upon a wholly unfounded contention that the District Court held evidence of consumer confusion to be inadmissible in trademark cases.

The District Court made no such ruling. Indeed, no occasion ever arose for such a ruling as no such evidence was ever properly placed before the Trial Court. Therefore, petitioner's long list of authorities for the undisputed proposition that evidence of confusion is relevant to the issues raised in trademark cases is wholly irrelevant here. It does not appear from the decisions in the cited cases that evidence of confusion was presented without the necessary foundation. Here, petitioner failed to establish the proper foundation for its evidence.

Thus, for example, the first of these witnesses, after being identified by name, address and occupation, was asked whether and where she or her family had purchased GET UP, and then, without more, was asked to state whether when she purchased it she had had "any belief as to what company put it out" (58a).

This formula was followed without material variation in the examination of all the witnesses in this category, both at the trial (57a-61a) and on depositions (63a-190a). None of these persons were asked the customary questions calculated to identify such witnesses in relation to the matter on which they were called to testify, or to show how they were selected, came to be called, or the group from which they were picked. Since petitioner made no attempt to show in what manner the witness had come to its attention, or how the witness acted at the time of making purchases the Trial Court was placed by petitioner in the position of having to guess whether petitioner's witnesses were competent.

Wigmore, in discussing the burden of proof, explains the importance of laying such a foundation:

> "* * * since the probabilities are all against a particular person, out of all persons, having been one to observe the particular matter in hand, it cannot be assumed that he is one of the few admissible persons, and his qualifications as to observation, or knowledge, must be made to appear beforehand. Such is the generally accepted rule.
>
> Hence, the witness, before he refers to the matter in hand, *must make it appear that he had the requisite opportunities to obtain correct impressions* on the subject; and the first questions put to him should be and usually are, directed to laying this foundation." *II Wigmore on Evidence* (3rd Ed.), § 654, p. 758.

The lack of an adequate foundation for the question, "When you purchased GET UP did you have any belief as to what company put it out?" was of concern to the Trial Court, particularly for the reason that this made it

impossible to judge the degree of care exercised by the witness who was asked the question, in making the purchase to which the question referred (552a). Without this, no answer that any of these witnesses might have made could be material evidence. The witnesses in answering the question would have been testifying in a vacuum. For this reason alone, the objections to the question were properly sustained.

Petitioner's statement of the case does not include any reference to petitioner's survey, *supra,* page 3, and petitioner does not complain to this Court about the District Court's refusal to accord to the survey any probative value, or about the decision of the Court of Appeals in affirming this ruling. However, the application of the same rule of evidence to the 100 or more depositions, resulting in their rejection, and to the proffered testimony of petitioner's witnesses has been made the basis on which this Court is asked to grant certiorari.

Certainly, this ruling was consistent with the test for establishing likelihood of confusion as phrased by the Trial Court, approved herein by the Court of Appeals, and previously stated by the Court of Appeals for the Tenth Circuit in *The Standard Oil Company* v. *Standard Oil Company,* 252 F. 2d 65 (1958).

2. *Petitioner's Claim That It Was Denied a Fair Trial Because It Was Not Advised of the Basis for Evidentiary Rulings is Without Substance.*

Petitioner's statement (Pet. 8-9) that "Whenever petitioner asked for the grounds for evidentiary exclusions, the trial judge refused to inform petitioner." is not correct. In the course of the direct examination by petitioner, the Trial Court again and again did state its reasons for sustaining objections (30a, 192a, 249a, 250a, 251a, 253a, 254a, 299a, 326a-327a, 436a).

Throughout the trial the Court gave consideration to the fact that the evidence was being submitted by counsel

who are specialists in the field. In sustaining an objection to the testimony of petitioner's expert witness, the Court remarked,

> "You know his purpose isn't competent. I think even he knows that. So put another question." (254a)

The Court made it plain that it was not going to waste time in explaining what, in its opinion, should not have to be explained, or to permit interruptions of the trial by unnecessary arguments on obviously objectionable questions. This is best illustrated by the three excerpts from the Trial Court's rulings selected by petitioner to show an arbitrary attitude on the part of the Court (Pet. 9). However, reading a short portion of the record leading up to the objections shows that these rulings relate to three different but classically objectionable questions of petitioner. Obviously, there was no need to explain the rulings on such questions.

This approach was quite within the Court's discretion in the conduct of the trial. The judge presiding at a trial is "not only empowered to keep a case moving within the bounds of reason but it is his duty to do so". *Peckham* v. *Family Loan Co.*, 262 F. 2d 422, 425 (C. A. 5, 1959).

Furthermore, in none of the instances cited by petitioner to show that the Court refused to explain its rulings (Pet. 8) was an actual request for such an explanation made. What petitioner requested of the Court in each instance was not an explanation of the Court's ruling but an opportunity to argue the question, the implication being that the petitioner knew the ground of the ruling. In fact, in several of these instances the request for permission to argue follows the Court's explanation of its ruling. For example, in sustaining an objection to a question (247a) the Court said, "The form is bad", only to have the petitioner repeat the error until the Court, refusing counsel's requests to be heard, finally said, "You know how to put a proper question, put one" (248a).

Petitioner's citation of *Griffin* v. *U. S.*, 336 U. S. 704, 707 (1949) in this connection is inappropriate because in that case this Court clearly indicated that it was because of the circumstances, namely, a death sentence, that the grounds of the dismissal of the appeal ought not to have been left to inference. It should be noted that petitioner's other authorities are similarly inappropriate.[3]

Petitioner's contention (Pet. 9) that it was injured by not being informed of the grounds for sustaining objections, on the theory that if the rulings had been explained the objections might have been cured, has little merit. In all but fourteen instances the testimony of the "more than one hundred witnesses" involved was produced in the form of depositions which could not have been cured and transformed into acceptable testimony.

B. The Questions Posed by Petitioner Are Abstract and Cannot Affect the Outcome of the Litigation Because the Decision Turned, Not on the Issue Upon Which Petitioner Seeks Certiorari, But Upon Undisputed Conclusions Which, Independently, Required That the Dismissal of the Complaint be Affirmed.

The granting of a writ for the narrow reasons claimed by petitioner would not affect the judgment of dismissal. The evidentiary issue discussed in the petition applies only to claimed evidence of confusion. In no way does it apply to the uncontroverted findings and conclusions with respect to the common use and descriptive meaning of the word "up", nor does it apply to the issues of laches

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[3] *McNabb* v. *U. S.*, 318 U. S. 332 (1943) and *Marshall* v. *U. S.*, 360 U. S. 310 (1959) cited by petitioner as authority for this Court to exercise its supervisory power are concerned with judicial supervision over criminal justice. The only civil case in which the *McNabb* case has been cited by this Court is *Thiel* v. *Southern Pacific Co.*, 328 U. S. 217 (1946) which has only been relied upon by this Court as authority for the proposition that a jury must be fairly impaneled. *Gibson* v. *Lockheed Aircraft Service, Inc.*, 350 U. S. 356 (1956) was a personal injury action and was appealed from the Trial Court's refusal to grant certain of defendant's instructions to the jury.

and estoppel. Even if the questions which petitioner asks this Court to decide in its favor had the significance which petitioner claims for them, certiorari would not be warranted because the answers to such questions would not be given in the context of meaningful litigation. *The Monrosa* v. *Carbon Black, Inc.*, 359 U. S. 180 (1959). Thus the granting of certiorari would be no more than an academic exercise.

1. *The Uncontroverted Conclusion of the District Court Being That Use of the Word "Up" is Free and Equal to All, the Excluded Evidence, Had It Been Admitted, Would Not Have Affected the Judgment of Dismissal.*

The Court found "no credible evidence that there is any similarity between plaintiff's trademark **7up** (also SEVEN-UP) and defendant's trademark GET UP except for the use of the word 'up' " (Finding 38, 657a). Furthermore it was found that the word "up" is descriptive with respect to beverages (Finding 19, 653a) and has been and still is in common use in beverage trademarks (*supra*, p. 4). The Court then came to the following conclusion:

> "The use of the word 'up' which appears on the products of both parties gives rise to no rights whatsoever of plaintiff against defendant because plaintiff does not own exclusive right to the use of the word 'up', the use of the word 'up' being free and equal to all." (Conclusion 6, 660a)

This uncontroverted conclusion and the findings upon which it is based fully support the statement of the Trial Court that had all the answers in all the depositions and by all the witnesses been permitted, as proffered, they would have been entitled to no weight (552a and Finding 37, 657a). This is so because it is a well recognized rule of law that trademark infringement is not established merely by use of the same descriptive term as a component part of two competitors' trademarks. *Coca-Cola* v. *Carlisle Bottling Works*, 43 F. 2d 119 (C.C.A. 6, 1930); *Dixi-Cola*

Laboratories v. *Coca-Cola Co.*, 117 F. 2d 352 (C.C.A. 4, 1941).

For the same reason, the franchise agreements about whose exclusion petitioner complains (Pet. 7-8) would have had no affect on the judgment of dismissal even if their ambiguity had been resolved in accordance with petitioner's interpretation.

2. *No Substantial Right of Petitioner Was Affected by the Holdings of the District Court Since Petitioner is Barred by Laches and Estopped by Acquiescence From Asserting Any Claim Against Respondent.*

The fact that petitioner raises solely an evidentiary issue with respect to attempted proof of confusion does not alter the fact that the District Court held that even if petitioner had proved a case of infringement, which it did not, it was barred by laches and estopped by acquiescence from asserting any claim against respondent for use of the trademark GET UP (Conclusions 8 and 9, 660a). The Court of Appeals affirmed the judgment.

The District Court was the second tribunal, the first being the Patent Office, to decide that petitioner's failure to protest or assert its claimed rights against respondent for over 25 years constituted laches which barred it from any relief, even if it had proved a case, and that it was also estopped by its acquiescence from complaining of respondent's use of the trademark GET UP (525a).

This Court has long held that laches bars injunctive relief in trademark or unfair competition cases where delay in asserting a claim of rights is inexcusable and so prolonged as to make it inequitable to interfere with the respondent's use of its trademark. This rule has particular application where, as here, petitioner claims exclusive rights in a word after having acquiesced in its adverse use by many others.

French Republic v. *Saratoga Vichy Co.*, 191 U. S. 427 (1903);
Saxlehner v. *Eisner*, 179 U. S. 19 (1900);
Saxlehner v. *Wagner*, 216 U. S. 375 (1910).

Clearly, petitioner asks this Court to review evidentiary rulings for possible errors which, even if found to exist, would not affect any substantial right of petitioner, for it is barred by laches and estopped by acquiescence.

Conclusion

The Court of Appeals has not departed from the usual course of judicial proceedings nor has it sanctioned such a departure by the District Court. Petitioner has not shown any reason which calls for the exercise of this Court's powers of supervision. The petition should be denied.

Respectfully submitted,

WALTER J. HALLIDAY,
60 East 42nd Street,
New York, New York 10017,
Counsel for Respondent.

Of Counsel:
OLIVER P. HOWES, JR.,
BERT A. COLLISON,
M. L. SEVERN,
New York, New York.

AVERY S. COHEN,
Cleveland, Ohio.